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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,479	07/09/2001	L. Carlton Brown JR.	006969-022311US	7465
20350 7590 01/03/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER ERB, NATHAN	
			ART UNIT 3628	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 09/902,479	Applicant(s) BROWN ET AL.	
	Examiner Nathan Erb	Art Unit 3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-32 is/are rejected.
- 7) ☒ Claim(s) 6-9, 14, 28 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicants' response to Office action was received on October 6, 2006.
3. Regarding applicants' arguments and amendments regarding the rejections of the claims under 35 U.S.C. 102 and 35 U.S.C. 103 from the previous Office action, applicants' arguments have been found to be persuasive. Therefore, all of the rejections under 35 U.S.C. 102 and 35 U.S.C. 103 from the previous Office action are hereby withdrawn. However, note the new rejections of the claims under 35 U.S.C. 103 in this Office action below.

### ***Claim Objections***

4. Claims 6-9, 14, 28, and 31 are objected to because of the following informalities:
  - a. In the first line of claim 6, please remove the word "in."
  - b. In the first line of claim 7, please remove the word "in."
  - c. In the first line of claim 8, please remove the word "in."
  - d. In the first line of claim 9, please remove the word "in."
  - e. In the second line of claim 14, please replace the word "AcivteX" with --ActiveX--.
  - f. Please add a period at the end of claim 28.
  - g. In the second line of claim 31, please replace the word "comprising" with --comprises--.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 8-9, 25, 27-28, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al., U.S. Patent No. 6,249,777 B1, in view of Goldberg et al., U.S. Patent No. 5,848,401.

As per **Claims 1 and 25**, Kara et al. discloses:

- a method (or system) for obtaining a postage stamp by a user system, comprising a processor (coupled to memory), a memory, and a printer, from a website (or central) server over a communications network (column 1, lines 21-32; column 6, lines 12-38; column 7, lines 4-19; column 8, lines 24-52; user system stores Demand program, so it must have a memory);
- requesting said stamp from said website (or central) server over the Internet (in a markup language format) (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; HTML is a markup language);
- receiving a markup language message over the Internet (in response to said user request) comprising encoded binary data representing a machine-readable portion of an indicium associated with said stamp, said indicium comprising a digital signature (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2;

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column 17, lines 12-30; HTML is a markup language; computers transmit information in the form of encoded binary data);

- using said print program, printing said machine-readable portion on a label by said printer (column 4, lines 7-37; column 13, line 59, through column 14, line 2);

- a software module stored in said memory for extracting an indicium from the markup language message ((column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2; column 17, lines 12-30; HTML is a markup language; software module is Demand program)

Kara et al. fails to disclose wherein a label is a pre-processed label. Goldberg et al. discloses wherein a label is a pre-processed label (column 2, lines 10-20; pre-printed label). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. such that a label is a pre-processed label, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that using pre-printed postage labels helps prevent postal fraud because the supply of pre-printed postal labels can be controlled (column 2, lines 10-20).

As per **Claim 2**, Kara et al. further discloses wherein said print program is downloaded from said website server and stored in said memory (column 4, lines 7-37; column 6, lines 12-38; JAVA; user system stores Demand program, so it must have a memory).

As per **Claims 3 and 27**, Kara et al. further discloses wherein said markup language includes a Standard Generalized Markup Language (SGML) (column 6, lines 30-38; HTML is an application of SGML).

As per **Claims 4 and 28**, Kara et al. further discloses wherein said markup language includes a Hypertext Markup Language (HTML) (column 6, lines 30-38).

As per **Claim 8**, Kara et al. further discloses wherein said print program does not require a license from the United States Postal Service to execute (no mention of such a licensing requirement in entire reference).

As per **Claim 9**, Kara et al. further discloses wherein said print program does not require a separate account from the United States Postal Service to execute (no mention of such an account requirement in entire reference).

As per **Claim 31**, Kara et al. further discloses wherein said indicium further comprises a serial number (column 4, lines 7-37).

As per **Claim 32**, Kara et al. fails to disclose wherein said pre-processed label has the security feature of individual label serial number. Goldberg et al. discloses wherein said pre-processed label has the security feature of individual label serial number (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time

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of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 25 such that said pre-processed label has the security feature of individual label serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

7. Claims 5, 10, 12-13, 15-16, 18-19, 21-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Meyer et al., U.S. Patent No. 6,915,271 B1.

As per **Claims 5 and 26**, Kara et al. and Goldberg et al. fail to disclose wherein said markup language includes an eXtensible Markup Language (XML). Meyer et al. discloses wherein said markup language includes an eXtensible Markup Language (XML) (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claims 1 and 25 such that said markup language includes an eXtensible Markup Language (XML), as disclosed by Meyer et al. Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claims 10 and 22**, Kara et al. discloses:

- a method (or a computer program product stored in a computer readable medium) for obtaining a postage stamp by a user system, comprising a processor, a memory, and a printer, from a website server over a communications network (column 1, lines 21-32; column 4, lines 7-

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37; column 6, lines 12-38; column 7, lines 4-19; column 8, lines 24-52; user system stores

Demand program, so it must have a memory; computer program product is Demand program);

- storing a print program downloaded from said website server over the Internet in said memory (column 4, lines 7-37; column 6, lines 12-38; column 8, lines 24-52; JAVA; user system stores Demand program, so it must have a memory);

- (code for) requesting said stamp from said website server over the Internet (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52);

- (code for) receiving a message over the Internet comprising encoded binary data representing a machine-readable portion of an indicium associated with said stamp, said indicium comprising a digital signature (column 1, lines 21-32; column 6, lines 12-38; column 8, lines 24-52; column 13, line 59, through column 14, line 2; column 17, lines 12-30; computers transmit information in the form of encoded binary data);

- using said print program, (code for) printing said machine-readable portion on a label by said printer (column 4, lines 7-37; column 13, line 59, through column 14, line 2).

Kara et al. fails to disclose wherein a label is a pre-processed label. Goldberg et al. discloses wherein a label is a pre-processed label (column 2, lines 10-20; pre-printed label). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. such that a label is a pre-processed label, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that using pre-printed postage labels helps prevent postal fraud because the supply of pre-printed postal labels can be controlled (column 2, lines 10-20).



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Kara et al. and Goldberg et al. fail to disclose wherein a message is an XML message. Meyer et al. discloses wherein a message is an XML message (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified above in this rejection such that a message is an XML message, as disclosed by Meyer et al. Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claims 12 and 23**, Kara et al. and Goldberg et al. fail to disclose communicating using an XML data structure. Meyer et al. further discloses communicating using an XML data structure (column 53, lines 9-19). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claims 10 and 22 such that it communicates using an XML data structure, as disclosed by Meyer et al. Motivation is provided by Meyer et al. in that XML provides more flexibility for designing web pages than HTML (column 53, lines 9-19).

As per **Claim 13**, Kara et al. further discloses submitting information in a postage request (column 9, lines 1-15). Kara et al. and Meyer et al. fail to disclose wherein information is a serial number that identifies said pre-processed label. Goldberg et al. discloses wherein information is a serial number that identifies said pre-processed label (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Kara et al. as modified in the rejection for

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claim 12 such that information is a serial number that identifies said pre-processed label, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

As per **Claim 15**, Kara et al., Goldberg et al., and Meyer et al. fail to disclose wherein a program is downloaded only once. However, that element/limitation was well-known to one of ordinary skill in the art at the time of applicants' invention. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 such that the print program is downloaded only once; in doing so, a program would be downloaded only once, as was well-known in the art at the time of applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of applicants' invention that downloading a program only once and saving it to one's computer saves time by avoiding having to download the program again when it is needed in the future.

As per **Claim 16**, Kara et al. further discloses wherein said print program is downloaded each time a user logs into said website server (column 4, lines 7-37; column 6, lines 13-38; column 8, lines 53-67; JAVA).

As per **Claim 18**, Kara et al. and Meyer et al. fail to disclose wherein said pre-processed label has the security feature of individual label serial number. Goldberg et al. discloses wherein

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said pre-processed label has the security feature of individual label serial number (column 2, lines 10-20; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 such that said pre-processed label has the security feature of individual label serial number, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that a serial number that identifies a pre-processed label can be used to deter fraudulent printing (column 2, lines 10-20; column 7, lines 12-35).

As per **Claims 19 and 24**, Kara et al. further discloses wherein the message further comprises a meter number, a (postal) rate class, and an amount of postage (column 4, lines 7-37; column 13, lines 41-50; column 17, lines 12-30).

As per **Claim 21**, Kara et al. further discloses using said print program, printing said meter number on said label by said printer; using said print program, printing said rate class on said label by said printer; and using said print program, printing said amount of postage on said label by said printer (column 4, lines 7-37; column 13, lines 41-50; column 17, lines 12-30).

8. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Kramer et al., U.S. Patent No. 6,163,772.

As per **Claims 6 and 29**, Kara et al. and Goldberg et al. fail to disclose wherein said print program (or software module) includes an ActiveX control. Kramer et al. discloses wherein said print program (or software module) includes an ActiveX control (column 13, lines 22-42). It

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would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claims 1 and 25 such that said print program (or software module) includes an ActiveX control, as disclosed by Kramer et al. Motivation is provided by Kramer et al. in that ActiveX controls enable parts of software to be embedded in web pages (column 13, lines 22-42).

9. Claims 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Gravell et al., U.S. Patent No. 6,098,058.

As per **Claims 7 and 30**, Kara et al. and Goldberg et al. fail to disclose wherein said print program (or software module) includes a dynamic link library (dll) file. Gravell et al. discloses wherein said print program (or software module) includes a dynamic link library (dll) file (column 6, line 52, through column 7, line 6; column 8, lines 15-24; column 9, lines 11-31). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claims 1 and 25 such that said print program (or software module) includes a dynamic link library (dll) file, as disclosed by Gravell et al. Motivation is provided by Gravell et al. in that a dll file can be used to perform postal metering functions, in particular, preventing the printing of postal indicia without proper payment accounting (column 6, line 52, through column 7, line 6; column 8, lines 15-24; column 9, lines 11-31).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Meyer et al. in further view of Kramer et al.

As per **Claim 14**, Kara et al., Goldberg et al., and Meyer et al. fail to disclose wherein said print program includes an ActiveX control. Kramer et al. discloses wherein said print program includes an ActiveX control (column 13, lines 22-42). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 such that said print program includes an ActiveX control, as disclosed by Kramer et al. Motivation is provided by Kramer et al. in that ActiveX controls enable parts of software to be embedded in web pages (column 13, lines 22-42).

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Meyer et al. in further view of Hind et al., U.S. Patent No. 6,978,367 B1.

As per **Claim 17**, Kara et al., Goldberg et al., and Meyer et al. fail to disclose wherein said encoded binary data is base 64. Hind et al. discloses wherein said encoded binary data is base 64 (column 26, lines 21-32). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 such that said encoded binary data is base 64, as disclosed by Hind et al. Motivation is provided by Hind et al. in that base 64 is a well-known option for encrypting data (column 26, lines 21-32).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al. in view of Goldberg et al. in further view of Meyer et al. in further view of Kara 2, U.S. Patent No. 6,233,568 B1.

As per Claim 20, Kara et al. and Meyer et al. fail to disclose using a microprint line. Goldberg et al. discloses using a microprint line (column 6, lines 60-65; column 7, lines 12-35). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 such that it uses a microprint line, as disclosed by Goldberg et al. Motivation is provided by Goldberg et al. in that microprint acts as a security feature (column 6, lines 60-65; column 7, lines 12-35).

Kara et al., Goldberg et al., and Meyer et al. fail to disclose using a logo in postal indicia. Kara 2 discloses using a logo in postal indicia (column 12, lines 43-48; column 23, lines 17-21). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Kara et al. as modified in the rejection for claim 10 and as modified above in this rejection such that it uses a logo in postal indicia, as disclosed by Kara 2. Motivation is provided by Kara 2 in that using a logo in postal indicia allows the indicia to be personalized (column 12, lines 43-48; column 23, lines 17-21).

### ***Conclusion***

13. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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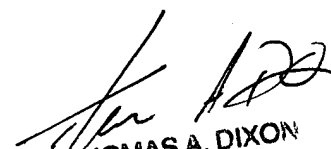
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Erb  
Examiner  
Art Unit 3628

nhe

  
THOMAS A. DIXON  
PRIMARY EXAMINER